

REMARKS

Claims 1 – 22 remain in the application and stand finally rejected. Claims 1, 4, 10, 16, 19 and 22 are amended by this proposed amendment. Although this amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 50-3818.

The MPEP provides in pertinent part “the examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application.” MPEP §2164.04 (emphasis original).

Claims 1 – 22 are finally rejected as being unpatentable under 35 U.S.C. §§102(e) or 103(a) over U.S. Patent No. 6,223,213 to Cleron et al.

With regard to claim 1, the Final Office Action (Final) responds to remarks in the previous amendment noting “that the claim merely requires an ‘activate signal’ which then ‘activates’ a video email feature.” Final page 2 #1. Thus, the Final concludes that because “Cleron discloses where a user will press a button to ‘activate’ a video email feature, i.e. the recording of a video clip to be inserted into a video email (Fig. 7; column 7, lines 9-44). Recording a video clip clearly meets the broad claim limitation of a video email ‘feature.’” *Id.*

Cleron et al. describes using capture panels 130, 150 for capturing images/video and storing the video 210. Col. 7, lines 9 – 13. Then, after storing the user can add stored clips to messages using an “Add to Message” button 138 or 158. *Id.*, lines 14 – 17. Thus, Cleron et al. describes two separate user activities required to get from recording to having an e-mail with the recorded video.

By contrast, pressing a single button to activate the video feature/module causes recording, e-mail creation and insertion into the e-mail. This is especially the case where a timer is used to send the end of clip signal. Recording does not begin just by providing input to cause the activate signal, the video feature must be active to send the start signal. Accordingly, claim 1

is amended to recite that the active video feature is causing the clip to be recorded and automatically attached to an e-mail. Claims 4, 10, 16, 19 and 22 are similarly amended by this proposed amendment. This amendment to the claims is supported, for example, by Figure 4 and the appurtenant description, e.g., on page 6, lines 9 – 24. For example, “[t]he video control module 402 supervises reception and storage of the video clip. The video control module is responsive to the start of clip and end of clip signals from the video input device 108.” *Id.*, lines 13 – 16. While the e-mail module controls opening and attaching, it does so because the video feature/module has been activated. No new matter is added. This is neither taught nor suggested by Cleron et al. or any other reference of record. Therefore, Cleron et al. fails to anticipate, and does not suggest, the present invention as recited in amended independent claims 1, 4, 10, 16, 19 and 22.

Moreover, dependent claims include all of the differences with the references, as the claims from which they depend. MPEP §2143.03. Therefore, regardless of whether it is well known to offer different compression formats as recited in claim 2, or use a timer to deactivate streaming video as recited in claims 3, 8, 14 and 21; by this amendment Cleron et al. fails to teach or suggest the present invention, as recited by claims 2, 3, 5 – 9, 11 – 15, 17, 18, 20 and 21, which depend from claims 1, 4, 10, 16 and 19. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 – 22 under 35 U.S.C. §§102(c) and 103(a) is respectfully requested.

The applicant thanks the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicant respectfully requests entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 – 22 under 35 U.S.C. §§102(c) and 103(a) and allowance of the application to issue.

As previously noted, MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that

certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration.** (emphasis added). The applicant continues to believe that the written description of the present application is quite different than and not suggest by any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Date: Thursday, February 18, 2010

Respectfully submitted,

By: /Charles W. Peterson, Jr. #34,406/
Charles W. Peterson, Jr.
Registration No. 34,406
Attorney for Applicants
Tel: 703-481-0532
Fax: 703-481-0585

SIEMENS CORPORATION
Customer Number: 28524
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830

Attn: Elsa Keller
Direct Dial: 1-732-321-3026